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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/086,327	05/28/1998	PHILIPPE L. DURETTE	19965Y	8099

7590 12/11/2002  
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EXAMINER	
LUKTON, DAVID	
ART UNIT	PAPER NUMBER

1653

DATE MAILED: 12/11/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/086,327

Applicant(s)

DURETTE ET AL.

Examiner

David Lukton

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-8, 11-16 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 is/are allowed.
- 6) ☒ Claim(s) 6-8, 11-16, 20, 21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Upon reconsideration, the prosecution of the instant application is re-opened. This Office action is non-final. Claims 6-8, 11-16, 20-23 remain pending.

Claim 22 is characterized as free of the cited art.

※

Claims 6-8, 11-16, 20, 21, 23 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In claim 11, line 1, the following is recited: "wherein R<sup>4</sup>is". Within this phrase, there should be a space between "R<sup>4</sup>" and "is".
- In claim 14, the following is recited:

"A compound of claim 13 wherein X is COOH; R<sup>1</sup> is phenyl substituted at the 3-position optionally having a second substituent wherein said substituents are independently selected from R<sup>b</sup>; **selected from R<sup>b</sup>**; R<sup>2</sup> is H; ..."

As is evident, the phrase "selected from R<sup>b</sup>;" occurs twice; this appears to be a typographical error.

- In claim 21, variables "R<sub>n</sub>" are recited, wherein "n" is an integer between 1 and 7 (i.e., R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub>, etc.). In claim 21, these integers (1-7) are shown as *subscripts*; in most of the dependent claims, however, these integers are shown as *superscripts* (i.e., R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, etc.). Consistency in this regard should be maintained.
- In formula Ia of claim 21, the ring bearing the group -SO<sub>2</sub>-R<sub>1</sub> contains substituent variables "B" and "Z". Claim 21 recites that "Z" is -C- or -C-C-, and that "B" can be -C-, -C-C- or -C=C-. However, in each case the carbon atoms (within "Z" and "B") are divalent or trivalent; in stable molecules, however, carbon must be tetravalent. Accordingly, the structure is indefinite as to what is permitted or

required to make up the full valence of carbon. The same rejection applies in the case of claim 15.

- Claim 23 is not properly subgeneric to claim 21. Claim 21 mandates that  $R_1$  can be one of a few select heteroaryl groups, or else  $R_1$  can be a phenyl group which can be substituted with one or two substituents, one of which must be present at the "3" position of the phenyl group. By contrast, there are several compounds within claim 23 which do not meet this limitation. For example, in the 14th compound listed in claim 23, variable  $R_1$  is 2,5-dichlorobenzenesulfonyl. Thus, claim 23 is not properly dependent on claim 21.

\*

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2) and (4) of section 371(c) of this title before the invention thereof by the applicant for the patent.

Claims 6-8, 11, 12, 14, 15, 16, 20 are rejected under 35 U.S.C. §102(e) as being anticipated by Thorsett (USP 6,489,300).

Thorsett discloses a genus of compounds (of formula I) beginning at col 3, line 16. Also taught (col 22, line 39+) are compositions containing the disclosed compounds. Several of the species recited in columns 23-64 anticipate the claimed genus. For example, the seventh compound in cols 45-46 is the following (substituent variables of Thorsett):

$R^1 = 3,4\text{-difluorophenyl}$

R<sup>2</sup>/R<sup>3</sup> = pyrrolidinyl

R<sup>5</sup> = *para*-[(CH<sub>3</sub>)<sub>2</sub>NC(O)O-]benzyl-

R<sup>6</sup> = OH

This corresponds to the substituent variables of instant claim 21 as follows:

R<sup>1</sup> = 3,4-difluorophenyl

B = -CH<sub>2</sub>-

Z = -CH<sub>2</sub>-

R<sup>2</sup> = hydrogen

R<sup>3</sup> = hydrogen

R<sup>4</sup> = hydrogen

R<sup>5</sup> = phenyl substituted with R<sup>y</sup>

R<sup>6</sup> = hydrogen

R<sup>7</sup> = hydrogen

R<sub>y</sub> = R<sub>x</sub>

R<sub>x</sub> = -O(CO)N(R<sup>d</sup>)R<sup>e</sup>

R<sup>d</sup> = methyl;

R<sup>e</sup> = methyl

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Thus, the claims are anticipated.

\*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

D.L. 12/5/02

  
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